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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/666,728   | 09/19/2003  | Jennifer Amys        | 1640.001US1                  | 6050                   |
| 21186 7590 06/04/2007<br>SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>ADAMS, CHARLES D |                        |
|  |             |                      | ART UNIT<br>2164             | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>06/04/2007      | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/666,728

Applicant(s)

AMYS ET AL.

Examiner

Charles D. Adams

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Remarks***

1. In response to communications filed on 12 March 2007, claims 1-3 are amended.  
Claims 1-3 are pending in the application.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The claims fail to place the invention squarely within one statutory class of invention. On page 6, lines 1-4, of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals, such as "conveyed as a data stream over a network". As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 rejected under 35 U.S.C. 102(e) as being anticipated by Horn et al. (US Pre-Grant Publication 2002/0156688).

As to claim 1, Horn et al. teaches a method comprising:

Two or more different software systems producing electronic data relating to a transaction involving documentation communicated in an electronic form (see paragraphs [0156] and [0313]);

Processing copies of the electronic data to identify electronic documentation items and at least one key value associated with an electronic documentation item (see paragraph [0507]);

Using the at least one key value to look up a unique transaction identifier associated with the transaction, wherein the transaction includes one unique transaction identifier and two or more associated key values (see paragraphs [0508] and [0519]-[0521]);

Indexing the documentation items according to the at least one key value and transaction identifier (see paragraph [0521]);

Archiving the documentation items in a data storage system or device (see paragraph [0508] and [0519]-[0521]); and

Logging one or more of a date and time associated with at least some of the documentation items (see paragraphs [0509]-[0515] and [0522]).

As to claim 2, Horn et al. teaches a data structure stored in a storage medium, comprising:

A transaction specification database that contains specifications and schema for one or more transaction types and key values of each transaction type (see paragraph [0519]);

A life cycle Index table that contains the key values of the processed transactions and assigned life cycle IDs for the key values (see paragraphs [0509]-[0515]);

An archive database that contains the archived documents or items and their life cycle IDs (see paragraph [0519]);

A log details database that provides chronological order to transactions by logging and time stamping each transaction parsed (see paragraph [0522]); and

Wherein:

Transaction data stored within the data structure is associated with transactions (see paragraphs [0519]), and

Data associated with a single transaction and stored in each of the transaction specification database, the life cycle Index table, the archive database, and the log detail database is searchable by a retrieval processor in a single query, wherein the retrieval processor is a computer process (see paragraph [0521]).

As to claim 3, Horn et al. teaches a system comprising:

A first interface used to couple the system with a first external system producing first electronic data relating to a transaction involving documentation communicated in

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an electronic form, wherein the first electronic data includes at least a first key value (see paragraphs [0156] and [0313]);

A second interface used to couple the system with a second external system producing second electronic data relating to the transaction, wherein the second electronic data includes at least a second key value (see Figure 1, element 1440 and paragraph [0519]); and

Wherein the system is operable to:

Process copies of the first and second electronic data to identify electronic documentation items and at least one key value associated with an electronic documentation item (see paragraph [0507] and [0519]-[0521]);

Use the key value to look up a unique transaction identifier associated with the transaction (see paragraphs [0508] and [0519]-[0521]);

Index the documentation items according to key value and unique transaction identifier (see paragraph [0521]);

Archive the documentation items (see paragraph [0508] and [0519]-[0521]); and

Log one or more of a date and time associated with at least some of the documentation items (see paragraphs [0509]-[0515] and [0522]).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles Adams  
AU2164

*Camry*  
Primary Examiner  
*Cam Y Tuong*